

Drawings

A replacement drawing sheet is submitted in response to Form PTO-948.¹ It is assumed the Examiner has withdrawn his objection to the drawings under 37 CFR 1.83(a) since the record does not reflect that the examiner's SPE maintains the objection.²

Claim Rejections

A. Rejection based upon 35 USC §112, second paragraph

Claims 6, 9, and 10 stand rejected. The Examiner's position is that the metes and bounds of independent claim 6 is uncertain because: a) it is uncertain which children are considered older and which adults are capable of stepping over; b) it is uncertain whether all children, able or disabled, will infringe on the subject matter; and c) the claim does not appear to cover all instances for all children and adults, especially the elderly, and therefore the claim would be uncertain.

As with the earlier rejection of claims 2-5 similarly upon 35 USC §112, second paragraph, the Examiner has elected not to suggest alternatives that are free from objection in accordance with MPEP §2173.05(a).

As the Examiner is well aware, during patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. MPEP §2173.05(a) citing *In re Morris*, 127 F.3d 1048, 1054; 44 USPQ 2d 1023, 1027 (Fed.Cir. 1997).

The invention is directed to a barrier to limit the movement of an infant across the barrier while allowing older children and adults (i.e. non-infants) to step across. The ordinary meaning of older children and adults should be used to distinguish from an infant. The Examiner seeks to impermissibly add limitations into the interpretation of the claim language such as elderly and

¹ The Replacement Sheet contains the three figures that were electronically submitted with the original application package.

² The Examiner's 04/15/2005 Interview Summary states that the Examiner agreed to withdraw the objection with the condition that the examiner's SPE might require the drawing.

disabled persons; neither of which should be pertinent to the issue at hand which is whether claim 6 is indefinite.

“The PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” MPEP §2111.

If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more. MPEP §2173.05(a) citing *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F2d. 613; 225 USPQ 634 (Fed. Cir. 1985).

Applicant believes those skilled in the art are reasonably apprised of the utilization and scope of the invention when claims 6, 9, and 10 are read in light of the specification. The Examiner, as one having skill in the art should therefore understand the invention to a point where if the metes and bounds of claim 6 are uncertain, a position which Applicant disputes, then the Examiner should offer suggestions to address this uncertainty as set forth in MPEP §2173.05(a).

Applicant believes claim 6 meets the required threshold standard established by *Shatterproof Glass Corp.* Accordingly, on the basis of the submitted argument, Applicant respectfully requests the Examiner to withdraw his rejection of claims 6, 9 and 10 on the basis of 35 USC §112, second paragraph, or suggest alternatives that are free from objection under MPEP§2173.05(a). With respect to the latter, Applicant’s attorney is available to discuss alternative language with the Examiner if he wishes to initiate an interview.

B. Rejection based upon 35 USC §102

The Examiner has rejected claims 2-10 on the basis of US Pat. No. 4,431,166 issued to Marshall. Marshall discloses a garbage can mat (i.e. a circular mat surrounding a garbage can in the center) having upward extending spikes designed to be driven into the area between a dog’s paw pads and cause the dog great pain if a dog were to stand upon the mat. (Col. 3, lines 56-59).

The spikes are designed of a length of 1.5 inches, spaced 1 inch apart. (Col. 4, lines 12-15). This length and spacing are necessary so the spikes have sufficient length to extend past the paw pads and reach the soft tissue lying between.

As the basis for each claim rejection, the Examiner takes the following position:

“...it is the patentability of the method steps that is to be determined and not the recited structure. Structure not affected in the manipulation sense is given no patentable weight”.

Applicant’s attorney is unaware of any provision in the MPEP, and the Examiner has not referenced any section of the MPEP or case law to substantiate his position. If a patent claim meets all of the statutory requirements as to form, is clear and definite and adequately distinguishes over the prior art, the claim cannot be objected to because structure is included within a method claim. All words in the body of a claim must be considered when determining a claim’s patentability over the prior art. Claims must be interpreted as broadly as their terms reasonably allow. MPEP §2111.01.

As presented in Applicant’s 04/07/2005 Response, Marshall does not teach nor suggest using its disclosed garbage can mat as a method for preventing movement of an infant from one area of a house to another by creating a barrier on a floor. Marshall discloses a spiked mat to prevent dogs from tipping over garbage cans, nothing more.

“In order for a dog to tip a garbage can over, it is necessary for the dog to place its front paws high enough on the garbage can to overcome the center of gravity of the garbage can and to place his full weight on his back paws. If a dog were to do so with a garbage can protected by my invention, the spikes of the garbage can mat would be driven between the dog’s pads and cause the dog great pain.”
(Col. 3, lines 52-59)

As used in Marshall, the term “mat” is a structure for standing upon. It is necessary for someone to stand upon the mat in order to reach the center and dispose of trash in the garbage can. If the diameter of the Marshall mat were reduced to the barrier width of Applicant’s invention (i.e. to function as an infant barrier but allow older children and adults to walk across), as the Examiner infers, then the Marshall mat would be so narrow that it would be possible for a large dog to likewise stand on his hind legs, avoid stepping upon the mat, and still knock over the garbage can. Such a scenario is contrary to the teachings of Marshall.

Applicant's method is unique in that the sheeting material need only be of a sufficiently narrow width to deter an infant from crossing. Claim 6 has the limitation "said sheeting material sized for older children and adults to step over while still providing sufficient depth to discourage an infant from attempting to cross". Given the motor skill possessed by an infant, that width is substantially less than the normal walking stride of an older child and adult. Therefore, it is not necessary that the sheeting material be sufficiently wide so *everyone* must step upon it in order to function as a barrier to an infant. By contrast, this is precisely what Marshall teaches, i.e. a mat to step upon.

For independent claims 2, 5 and 6, the Examiner states that Marshall discloses:

For claim 2,

providing low-profile upward extending sections 2;
appropriately sizing the length and the depth of a sheeting material 6 to substantially conform to a floor; and,
positioning the sheeting material across a portion of the floor.

For claim 5,

providing a sheeting material 6;
appropriately sizing the sheeting material 6; and,
positioning the sheeting material 6, appropriately sized, in a desired location upon the floor.

For claim 6,

providing a sheeting material;
sizing the sheeting material; and,
placing the sheeting material upon a floor in a substantially desired location.

The Examiner is referred to MPEP §2114: "Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference."

Again, all words of a claim must be considered when determining patentability. Pending claims 2-10 can not be anticipated by Marshall because each of these pending claims contain additional limitations; limitations which Marshall does not teach nor suggest.

For these reasons, the Marshall reference can not anticipate Applicant's invention.

With respect to the cases cited by the Examiner³, these address ordinary skill in the art in the context of obviousness; and are not relevant to an objection based on 35 USC§102.

C. Rebuttal to Examiner's "Response to Arguments"

In his "Response to Arguments" section, the Examiner stated: "it is not the preamble that defines the claims but rather the steps in the body of method claims." Applicant believes this statement to be incorrect. Method claims are not treated differently than structural claims in this respect.

If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." MPEP §2111.02 citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)

and,

"Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation". MPEP §2111.02 citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251 (Fed. Cir. 1989).

The Examiner takes the positions: "...applicant has not set forth what step Marshall fails to teach." And "it is not the applicant's low profile barrier that is in question, but rather the capabilities of Marshall's profile barrier."

Although the Examiner doesn't use the term "inherency", this is precisely his argument, that Applicant's invention is inherent within the teachings of Marshall.

Quoting from MPEP §2112, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993).

Also from MPEP §2112, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however,

³ *In re Sovish*, 769 F.2d 738; *In re Boe*, 355 F.2d 961; and *In re Preda*, 401 F.2d 825.

may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP §2112 citing *Ex parte Levy*, 17 USPQ2d 1461, 1646 (Bd. Pat. App. & Inter. 1990).

Therefore, it is the Examiner who is responsible for stating his reasons for basing a 102 rejection upon inherency. It is not the responsibility of the Applicant to set forth what step Marshall fails to teach.

“To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art references convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Associates, Inc. v. Garlock Inc.*, 721 F.2d 1540; 220 USPQ 303 (Fed. Cir. 1983)

For the pending application, the Examiner has not provided any basis in fact or technical reasoning as required by *Ex parte Levy*. In effect, the Examiner improperly utilizes hindsight to support his unsubstantiated position that the pending claims are rooted in the Marshall reference when there is absolutely no suggestion of using Marshall as an infant barrier. By contrast, applicant has presented argument illustrating that the mat described in Marshall could not carry out its intended function and also function as an infant barrier as this term is used in the specification.

For the above reasoning, a rejection to any of the claims based upon inherency, either explicit or implied, can not be substantiated by the Marshall reference and the rejections are respectfully requested to be withdrawn.

CONCLUSION

Applicant believes each of the Examiner's objections and rejections have been properly addressed. It is requested the current objections be withdrawn and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Dated: May 10, 2005

A handwritten signature in black ink, appearing to read "Ralph D. Chabot", with a long horizontal flourish extending to the right.

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